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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/193,787	11/17/98	DRUMMOND	J D1077+1

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TM02/1105

EXAMINER

WORJLOH, J

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 11/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/193,787

Applicant(s)

DRUMMOND ET AL.

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 1998 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8,10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-27 have been examined.

Priority

2. This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior application. A statement reading "This is a continuation-in-part of Application No. PCT/US97/21422, filed 11/25/97." should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of all nonprovisional parent applications referenced should be included.

Information Disclosure Statement

3. The information disclosure statement filed May 14, 2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "48" and "44" have both been used to designate journal printer (see pg. 48, line 13 and fig.2. Correction is required.
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "44" has been used to designate both depository and journal printer (see fig. 2). Correction is required.

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6. Applicant is required to submit a proposed drawing correction in reply to this Office action.

However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5963647 to Downing et al. in view of U.S. Patent No. 5884288 to Chang et al. Downing et al. discloses an automated banking machine, including: an output device, wherein the output device outputs information, whereby a user is enabled to perceive outputs from the output device; an input device, wherein the input device is operative to receive inputs, whereby a user is enabled to provide inputs to the machine; a transaction function device, wherein the transaction function device is selectively operative to carry out a transaction function (see col. 4, lines 61-67 and col. 5, line 1); a computer, wherein the computer is in operative connection with the output device, the input device and the transaction function device(see col. 5, lines 30-33). Note. The personal computer is "configured to operate as CAT"; therefore it is in operative connection with the output device (see col. 4, lines 61-67 and col. 5, line 1). Downing et al. also disclose a software executable that controls the transaction function device (see col. 5, lines 13-15). Downing et al. does not expressly disclose a browser, wherein the browser is operative to process HTML documents including

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instructions therein, and wherein the transaction function device is operative to carry out the transaction function responsive to the browser processing at least one document including at least one instruction adapted to cause the computer to cause operation of the transaction function device. However, Chang et al. discloses to a browser, wherein the browser is operative to process HTML documents (i.e. "web page") including instructions therein (see col. 4, lines 29-31), and wherein the transaction function device is operative to carry out the transaction function responsive to the browser processing at least one document including at least one instruction (see col.4, lines 46-48) adapted to cause the computer to cause operation of the transaction function device (see col. 3, lines 55-56; col. 4, lines 52-54, 58-60; col. 6, lines 36-37 and 43-49). Note. It is known in the art that HTML documents have embedded commands or instructions, and web browser programs processes HTML documents. Also, the examiner interrupts at least one instruction as "payment instructions" and "payee computer system" as transaction function devices. Hence, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the automated banking machine in Downing et al. to include a browser operative to process HTML documents with embedded instructions to carry out transaction functions as disclose by Downing et al. which is software executable that controls the transaction function device. One of ordinary skill in the art would have been motivated to do this because HTML documents have embedded commands that can be programmed to perform numerous transactions.

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Referring to claim 2-6, Downing et al. an automated banking machine wherein the transaction function device includes a sheet dispenser (see col. 4, line 66), a card read (see col. 4, lines 63-64), a depository (see col. 4, line 65), and a keyboard (see col. 5, lines 6-8).

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al. and Chang et al. as applied to claim 1 above, and further in view of U.S. Patent No. 5905248 to Russell et al. Russell et al. discloses a software that is operative responsive to an instruction to access at least one HTTP record address (i.e. "URL"), wherein the at least one HTTP record address corresponds to at least one HTTP record (i.e. "HTML document") including instructions adapted to cause the computer to cause operation of the transaction function device (see col. 2, lines 21-23, col. 3, lines 20-24 and col. 21, lines 43-45). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to design a system that have a software wherein the software is operative responsive to an instruction to access a HTTP record address wherein the HTTP record address corresponds to a HTTP record including instructions adapted to cause the computer cause operation of the transaction function device. One of ordinary skill in the art would have been motivated to do this because HTTP is the primary protocol used by the World Wide Web, which defines what actions web browsers should take in response to various commands.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5884288 to Chang et al. in view of U.S. Patent No. 5963647 to Downing et al. Chang et al. discloses a computer (see col. 3, lines 50-51), a browser operating in the computer (see col.

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4, lines 29-31) and a transaction function device (i.e. "electronic deposit repository") in operative connection with the computer (see col. 6, lines 36 and 46-47), wherein the transaction function device is operative carry out a transaction function responsive to at least one HTML format document that is received by the browser (see col. 4, lines 46-48 and 56-60). Chang et al. does not disclose an ATM, wherein the transaction function is operative to cause the ATM to carry out transaction function. However, Downing et al. discloses an ATM with software executable that causes transaction function device to perform a transaction function (see co. 4, lines 47-50 and col. 5, lines 13-15). The examiner interrupts the software as a web browser software that process HTML documents. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the ATM system in Downing et al. to include a browser that receives at least one HTML format document to cause the ATM to carry out a transaction, as disclosed by Downing et al. which is software executable that controls the transaction function device. One of ordinary skill in the art would have been motivated to do this because HTML format documents have embedded commands that can be utilized to perform various transactions.

11. Claims 9-13, 16, 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5884288 to Chang et al. in view of U.S. Patent No. 5963647 to Downing et al. Chang et al. discloses operating a browser in at one computer (see col.3, lines 50-51; col. 4, lines 29-31), receiving at least one HTML format document with the browser, wherein the at least one HTML format document includes at least one transaction instruction (i.e. "payment instructions") (see col. 4, lines 29-31, 46-47 and 56-57), carrying out at least one transaction

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function with a transaction function device to the at least one HTML format document, including the transaction instruction (see col. 4, lines 29-30, 46-48 and 58-60, col. 6, lines 36-37 and 46-49). Chang et al. does not disclose an automated banking machine, wherein the transaction function device in the automated banking machine responsive to the HTML format document carries performs a transaction function. However, Downing et al. discloses an automated banking machine with a software executable that causes transaction function device to perform a transaction function (see col. 4, lines 47-50 and col. 5, lines 13-15). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the automated banking machine in Downing et al. to include a browser that receives at least one HTML format document with at least one transaction instruction to carry out at least one transaction function as disclose by Downing et al. which is software executable that controls the transaction function device. One of ordinary skill in the art would have been motivated to do this because HTML format documents have embedded commands, which can be coded to perform various transactions.

Referring to claim 10, Downing et al. discloses an output device in operative connection with the computer (see col. 4, lines 63-66; col. 5, lines 31-32), producing an output through the output device responsive to the execution of the software (see col. 5, lines 13-15). Downing et al. does not expressly disclose the HTML format document. Chang et al. discloses at least one HTML format document (see col. 4, lines 29-31). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the output device that produces an output in Downing to include a browser operative to receive at least one

HTML format document. One of ordinary skill in the art would have been motivated to do this because HTML format documents have embedded commands, which can be coded to perform various transactions.

Referring to claim 11, Chang et al. discloses operating a browser in at least one computer (see col. 3, lines 51-52 and col. 4, lines 29-31) receiving at least one document with the browser, wherein the document includes at least one transaction instruction embedded therein (see col. 4, lines 46-47 and 56-57), carrying out at least one transaction function with a transaction function device responsive to the at least one document including the at least one transaction instruction (col. 4, lines 29-30, 46-48, 58-60, col. 6, lines 46-47). Chang et al. does not disclose an automated banking machine. Downing et al. discloses an ATM with a software executable that causes the transaction function device to perform a transaction function (see col. 4, lines 47-50; col. 5, lines 13-15). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the ATM system in Downing et al. to include a browser that receives at least one document with at least one transaction instruction to carry out at least one transaction function as disclosed by Downing which is a software executable that controls transactions. One of ordinary skill in the art would have been motivated to do this because of the reason indicated above.

Referring to claim 12, Downing et al. discloses an automated teller machine that operates to conduct at least one financial transaction in response to an software (see col. 5, lines 13-15). Downing et al. does not expressly disclose a mark-up language document. Chang et al.

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disclose a financial transaction responsive to at least one mark-up language document (see col. 4, lines 46-48 and 56-60). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to do design an automated teller machine that operates to conduct at least one financial transaction responsive to at least one mark-up language document. One of ordinary skill in the art would have been motivated to do this because most electronic transactions are perform on web sites which are created using at least one mark up language.

Referring to claim 13, Chang et al. discloses a computer (see col. 3, lines 50-51), wherein the computer is adapted to cause at least one banking transaction be carried out through operation of the at least one transaction function device responsive to at least one mark up language document (see col. 4, lines 46-48 and 56-60). Chang et al. does not expressly disclose an automated banking machine, wherein at least one transaction function device in the banking machine adapted to carry out at least a portion of a banking machine. Downing et al. discloses an automated banking machine, and at least one transaction function device in the banking machine adapted to carry out at least a portion of a banking transaction (see col. 4, lines 62-65). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the ATM system in Downing et al to include a computer which is adapted to cause at least one banking transaction to be performed through operation of at least one transaction function device responsive to at least one-mark-up language. One of ordinary skill in the art would have been motivated to do this because most electronic transactions are perform on web sites which are created using at least one mark up language.

Referring to claim 16, Downing et al. discloses providing an automated banking machine including at least one transaction function device (see col. 4, lines 63-64). Downing et al. does not expressly disclose an automated banking machine in operative connection with at least one computer, processing at least one mark up language document with the computer, or carrying out at least a portion of a banking transaction function with the transaction function device responsive to processing the at least one mark up language document with the computer. However, Chang et al. discloses a computer (see col. 3, lines 50-51), processing at least one mark up language with the computer (see col. 3, lines 50-51; col. 4, lines 29-31), and carrying out at least a portion of a banking transaction with the transaction function device responsive to processing the at least one mark up language document with the computer (see col. 3, lines 55-56; col. 4, lines 46-47, 56-60). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the ATM system in Downing et al. to include a computer to process at least one mark-up language document to carry out at least a portion of a banking transaction. One of ordinary skill in the art would have been motivated to do this because computers have memory which can store the portion of a banking transaction and execute a prerecorded list of instructions.

As for claims 18-21, Downing et al. discloses a method wherein the transaction function device includes at least one reader device, and wherein the portion of the transaction includes reading indicia with the reading device (see col. 4, lines 61-65); a method wherein the reading device includes a card reader, and wherein an indicia is read from a card (see col. 4,

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lines 61-65); a method wherein the transaction function device includes at least one key, and wherein the portion of the banking transaction includes sensing an input through the at least one key (see col. 10, lines 40-42); a method wherein the transaction function device includes a depository, and wherein the portion of the banking transaction includes receiving a deposit with the depository (see col. 4, lines 61-65). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have the transaction function device include at least one reader device, wherein the reading device includes a card reader for reading indicia from a card; at least one key, wherein the portion of the banking transaction includes sensing an input through the at least one key; and a depository for receiving a deposit. One of ordinary skill in the art would have been motivated to do this because these are essential components an automated banking machine. That is, a card reader device identifies the encrypted data imprinted on the card, the key provides additional security, and the depository allows the customer to perform deposits.

12. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. and Downing et al. as applied to claim 13 above, and further in view of Russell et al. Russell et al. discloses a system wherein the computer includes document handling software, and wherein the computer is operative to carry out the at least one banking transaction responsive to the document handling software processing the at least one mark up language document (see col. 25, lines 34-40). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to design a system wherein the computer includes document handling software, and wherein the computer is operative to carry out the at least

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one banking transaction responsive to the document handling software processing the at least one mark up language document. One of ordinary skill in the art would have been motivated to do this because a document handling software manages a document file and enables performing various kinds of operations.

13. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. and Downing et al. as applied to claim 13 above, and further in view of U.S. Patent No. 4337864 to McLean. McLean et al. discloses a method, wherein the transaction function device includes a note dispenser, and wherein the at least one banking transaction includes dispensing at least one from the note dispenser (see col. 6, lines 66-68; col. 7, lines 1-4 and col. 8, line 37-38). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to design a system wherein the transaction function device includes a note dispenser, and wherein the at least one banking transaction includes dispensing at least one note from the note dispenser. One of ordinary skill in the art would have been motivated to do this because the note dispenser is needed to distribute notes to the customer, which is its primary function.

14. Claims 17 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. and Downing et al. as applied to claim 16 above, and further in view of McLean. McLean discloses an ATM, wherein the transaction function device includes a note dispenser, and wherein the at least one banking transaction includes dispensing at least one note from the note dispenser (see col. 6, lines 66-68; col. 7, lines 1-4 and col. 8, line 37-38).

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At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to design a system wherein the transaction function device includes a note dispenser, and wherein the at least one banking transaction includes dispensing at least one note from the note dispenser. One of ordinary skill in the art would have been motivated to do this because the note dispenser is needed to distribute notes to the customer, which is its primary function.

As for claims 22 and 26, Downing et al. discloses the banking machine with at least one output device (see col. 4, lines 63, and 66) and providing at least one output through the output device responsive to execution of the software (see col. 5, lines 13-15). Downing et al. does not expressly disclose at least one mark up language document. However, Chang et al. discloses processing at least one mark up language document with the computer (see col. 3, line 50-51 and col. 4, lines 29-30). Hence, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the banking machine in Downing et al. to include the step of providing at least one output through the output device responsive to processing at least one mark up language document with the computer. One of ordinary skill in the art would have been motivated to do this because financial transactions are being performed frequently on various web sites, which are created using at least one mark up language.

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As for claims 23 and 25, Chang et al. discloses a method wherein the computer includes browser software, and wherein at least one output is provided responsive to the browser software processing the at least one mark up language document (see col. 3, lines 50-51 and col. 4, lines 29-31, col. 6, lines 10-12; see fig. 3, item 304). Also, referring to claim 24, Chang et al. discloses the method wherein at least on HTML document is process by the computer (see col. 3, lines 50-51 and col. 4, lines 29-31).

As for claim 24, Downing discloses the output device as a screen, wherein at lest one output includes a visual output through the screen (see col. 8, lines 20-23).

15. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. and Downing et al. as applied to claim16 above, and further in view of Russell et al. Russell et al. discloses a method wherein the computer is operative to cause the carrying out of the banking transaction responsive to at least one software applet (see col. 6, lines 39-46 and col. 21, lines 43-45). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to develop a method wherein the computer is operative to cause the carrying out of the banking transaction responsive to at least one software applet. One of ordinary skill in the art would have been motivated to do this because web browsers can interpret applets from web servers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications, 703-746-7240 for Non-Official/Draft communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

October 29, 2001



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